



1/11 DAE

PATENT

Attorney Docket No. 08702.0010-12000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
)  
09/935,144 ) Group Art Unit: 1646  
)  
Patent No.: 7,563,760 ) Examiner: Xiaozhen Zie  
)  
Issued: July 21, 2009 )  
)  
For: NOVEL P-SELECTIN LIGAND )  
PROTEIN )

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**APPLICATION FOR PATENT TERM ADJUSTMENT-POST GRANT**

In accordance with 37 C.F.R. § 1.705(b), Patentee hereby applies for patent term adjustment under 35 U.S.C. § 154(b) of 1160 days. This application is being filed within two months of issuance of the above patent, as required by 37 C.F.R. § 1.705(d).

**I. Periods of Delay**

**A. Relevant Dates for Calculating Applicant Delay**

Applicants' Action	Relevant Rule
Applicants responded on May 20, 2004, to a restriction requirement mailed February 18, 2004, resulting in 2 days of Applicant delay.	1.704(b)
Applicants responded on January 7, 2005, to an Office Action mailed August 10, 2004, resulting in 58 days of Applicant delay.	1.704(b)

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<b>Applicants' Action</b>	<b>Relevant Rule</b>
Applicants filed a Notice of Appeal on February 28, 2006, in response to a final Office Action mailed August 28, 2005, resulting in 91 days of Applicant delay.	1.704(b)
Applicants responded on March 30, 2007, to an Office Action mailed October 4, 2006, resulting in 85 days of Applicant delay.	1.704(b)
Applicants filed a Request for Continued Examination on December 28, 2007, in response to a final Office Action mailed June 29, 2007, resulting in 90 days of Applicant delay.	1.704(b)/1.703(b)(1)
Applicants filed a Status Inquiry on February 10, 2009 after the Notice of Allowance was mailed March 5, 2008, resulting in 120 days of Applicant delay.	1.704(c)(10)

**B. Relevant Dates for Calculating PTO Delay**

<b>PTO's Action</b>	<b>Relevant Rule</b>
The Office mailed a Restriction Requirement on September 16, 2008, 330 days after the 14-month anniversary of the filing date, resulting in 330 days of PTO delay.	1.703(a)(1)
The Office mailed a non-final Office Action on October 4, 2006, 218 days after a Notice of Appeal was filed February 28, 2006.	1.703(b)(4) <sup>1</sup>
This patent issued July 1, 2009, 270 days after the four-month anniversary of payment of the Issue Fee, resulting in 270 days of PTO delay.	1.703(a)(6)

<sup>1</sup> States that these days do not apply to the three-year pendency calculation provided by § 1.703(b).

### **C. Terminal Disclaimer**

The above-identified application is not subject to a Terminal Disclaimer.

## **II. Remarks**

### **A. Pre-Grant Application**

Prior to grant of this patent, Patentees filed an Application For Patent Term Adjustment Pre-Grant ("Application") on May 20, 2008. The Office responded in a Decision mailed June 22, 2009 by holding that portion of the Application relating to three-year-pendency in abeyance pending the issuance of the patent. Decision, p. 1.

In addition, the Office dismissed in part Patentees' application. Specifically, Patentee contended that the Office mailed an Office Action on October 4, 2006, 218 days after Applicants filed the February 28, 2006, Notice of Appeal. Application at 2. Patentees' included this 218 days in Applicant delay. *Id.* The Office has pointed out that the 218 day period is not attributable to Applicant or the PTO under § 1.703. Decision at 3.

### **B. Post-grant Application**

In view of the dates in Parts I A and B above, Patentee submits that it is entitled to a total patent term adjustment of at least 1160 days based on *Wyeth v. Dudas*, 88 U.S.P.Q.2d 1538 (D.D.C. 2008).

The application was filed on August 21, 2001. The three-year anniversary of the filing date was August 21, 2004. Patentee filed a Request for Continued Examination on December 28, 2007. Thus, under § 1.703(b)(1) the initial patent term adjustment for examination delay under the three-year pendency rules is 1224 days. This is longer than examination delay calculated under § 1.703(a).

Applicant delay is subtracted from this adjustment. Applicant delay was 446 days, which is the sum of the periods in Part I.A. In addition, the 218 day period between the Notice of Appeal filed February 28, 2006 and the Office Action of October 4, 2006 is not included in three-year pendency. § 1703(b)(4). Consequently, the adjustment under the Rules is 1224 days minus 664 days (446 + 218), or 560 days.

Patentee is entitled to more days of adjustment than provided by the Rules. As indicated by the *Wyeth* decision, the Office has incorrectly calculated periods of overlap. Specifically, PTO delay during the period for calculating three-year pendency does not overlap PTO delay that occurs outside that period. See *Wyeth*, U.S.P.Q.2d at 1540-41.

For this Patent, there are two periods that do not overlap the period for calculating three-year pendency. First, there was a 330 day delay between the 14-month anniversary of the filing date and the first Office Action on the merits. This period occurred **before** the three-year anniversary of the filing date and is a non-overlapping period. *Id.* Second, the Office issued this patent 270 days after payment of the issue fee. This period occurred **after** the three-year pendency calculation as three-year pendency is tolled by the filing of an RCE. § 1.703(b)(1). Consequently, 600 days (330 + 270) is added to the 560 days as calculated under the Office's interpretation of the Rules. This gives a total patent term adjustment of 1160 days.

In conclusion, if the Office adopts the calculation methods according to the *Wyeth* decision, this patent is entitled to 1150 days of patent term adjustment. if the Office does not adopt these methods, it appears this patent is entitled to 560 days of patent term adjustment.

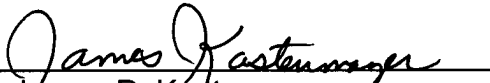
**III. Fee**

As required by 37 C.F.R. § 1.705(b)(1), this application is accompanied by a check for \$200.00 to cover the required fee. Please charge any deficiencies to Deposit Account 06-0916. If there are any other fees due in connection with the filing of this request, please charge them to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: September 3, 2009

By:   
James P. Kastenmayer  
Reg. No. 51,862  
(202) 408-4118